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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,101	12/11/2000	Benoit Ambroise	10244	3915

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EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/02/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,101

Applicant(s)

AMBROISE ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (US 5,455,217) in view of Aurenty et al (US 6,276,273) or Leeds (US 3,877,372). Chang discloses a thermal dye transfer system comprising a porous, high-density polyethylene (HDPE) film being covered on its surface with a dye receiving layer (column 19, lines 3-15). Chang discloses the film being biaxially oriented and having a network of interconnecting pores (example 1 and column 8, lines 9-10). Chang is silent as to the silicone glycol composition in the dye receiving layer. Aurenty teaches a printing plate substrate having an ink receptive layer being treated with a siliconated surfactant (abstract, column 4, lines 18-22 and figure 1). Leeds teaches a printing plate having an ink receptive layer being treated with a silicone glycol copolymer (column 1, lines 62-64, claim 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the surface of the dye receiving layer with the siliconated surfactant motivated by the desire to improve the resolution of the dye receiving layer for achieving successful printing.

With regard to claims 3, 4 and 7, Chang discloses the thermal dye transfer system wherein the microporous layer comprises a nucleating agent (column 10, lines 38-42, and column 6, line 6).

With regard to claims 5 and 6, Chang discloses the thermal dye transfer system further comprising three microporous film layers (table 2). It is the examiner's position that the article of Chang as modified by Aurenty or Leeds is identical to or only slightly different that the claimed article prepared by the method of the claim, because both articles use the same materials, having structural similarity (support film layer/microporous HDPE film layer/dye receiving layer). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). Chang/Aurenty or Chang/Leeds references strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and

how the Comparative Examples are commensurate in scope with Chang/Aurenty or Chang/Leeds.

With regard to claim 8, Chang discloses the thermal dye transfer system having a receptor base laminated to the microporous film layer (table 2, column 5, line 61 et seq.). See product by process rational in paragraph above with respect to claim 5.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato et al (US 5,468,712) in view of Aurenty et al (US 6,276,273) or Leeds (US 3,877,372). Minato discloses dye image receiving sheet comprising a substrate sheet that is comprises of a biaxially oriented porous polypropylene film layer and a dye image receiving layer formed on a front surface of the substrate sheet (figure 1, column 4, 54-58). Minato discloses the porous polypropylene film having a network of interconnecting pores (column 3, lines 30-33). Minato does not specifically disclose the porous film formed from HDPE. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ HDPE to form a porous film layer of Minato because HDPE is a typical, desirable and inexpensive material for making a biaxially, oriented film.

Minato is silent as to the silicone glycol composition in the dye receiving layer.

Aurenty teaches a printing plate substrate having an ink receptive layer being treated with a siliconated surfactant (abstract, column 4, lines 18-22 and figure 1).

Leeds teaches a printing plate having an ink receptive layer being treated with a silicone glycol copolymer (column 1, lines 62-64, claim 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

modify the surface of the dye receiving layer with the siliconated surfactant motivated by the desire to improve the resolution of the dye receiving layer for achieving successful printing.

With regard to claims 3-7, Chang discloses the dye image receiving sheet wherein the substrate sheet consisting of two or more biaxially oriented porous film layers with a filler being CaCO_3 (column 4, lines 55-58, column 5, line 43).

With regard to claim 8, Minato discloses the dye image receiving sheet having an additional layer laminated to the substrate sheet (column 6, lines 28-31).

Response to Arguments

4. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.
5. The art rejections/specification objections in Paper no. 8 have been overcome by the present amendment and response.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
June 21, 2002

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER